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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/653,384	09/01/2000	Steven L. Sholem	6299-A-01	7084

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SCHMEISER OLSEN & WATTS  
18 E UNIVERSITY DRIVE  
SUITE # 101  
MESA, AZ 85201

EXAMINER

BLECK, CAROLYN M

ART UNIT PAPER NUMBER

3626

DATE MAILED: 07/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/653,384

Applicant(s)

SHOLEM, STEVEN L.

Examiner

Carolyn M. Bleck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 39, 42-51 and 53-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 39, 42-51, 53-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Notice to Applicant***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 27 April 2006 has been entered.
2. This communication is in response to the RCE filed on 27 April 2006. Claims 39, 42-51, and 53-61 are pending. Claims 39 and 53 have been amended.

### ***Claim Rejections - 35 USC § 112***

3. The rejections of claims 39, 42-51, and 53-61 made under 35 U.S.C. § 112, 1<sup>st</sup> and 2<sup>nd</sup> paragraph, in the previous Office Action are hereby withdrawn due to the amendment filed on 27 April 2006.
4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 39, 42-51, and 53-61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 39 has been amended to recite "generating an indication of when a patient's requested appointment should be scheduled after the patient is accepted as a new patient." Claim 39 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: a step of accepting the patient as a new patient. It appears that the step of "generating an indication of when a patient's requested appointment should be scheduled" only occurs after the patient is accepted. If the patient is never accepted, this step does not occur. Thus, it appears the claim requires a step of accepting the patient. Further, it does not appear that the step of "generating an indication of when a patient's requested appointment should be scheduled after the patient is accepted as a new patient" relates to the previous steps nor to the calculation of a NPV.

Claims 42-51 and 53-61 incorporate the deficiencies of independent claim 39, through dependency, and are also rejected.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 39, 42-51, 53, and 59-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keyes et al. (6,456,983) in view of Jones (6,044,351) and Evans

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(5,924,074), for substantially the same reasons given in the previous Office Action.

Further reasons appear below.

(A) Claim 39 has been amended to recite “generating an indication of when a patient’s requested appointment should be scheduled after the patient is accepted as a new patient.” Evans discloses enabling a healthcare provider to schedule a patient appointment using a point and click interface by selecting an appointment data and an appointment time, and wherein the healthcare provider can review prior or future scheduled appointments by clicking on an appointment button (Figure 2, col. 5 line 29 to col. 6 line 9).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Evans within the system of Keyes and Jones with the motivation of quickly and efficiently capturing patient data (Evans; col. 2 lines 20-45).

The remaining features are rejected for the same reasons given in the previous Office Action, and incorporated herein.

(B) Claims 42-51 and 56-61 have not been amended, and are therefore rejected for the same reasons given in the previous Office Action, and incorporated herein.

(C) Claim 53 has been amended so that the claim now relies on claim 39 rather than claim 52. This amendment does not change the scope of the claim and/or the

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interpretation of the claim, and thus claim 53 is rejected for the same reasons given in the prior Office Action, and incorporated herein.

8. Claims 54-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keyes et al. (6,456,983) in view of Jones (6,044,351) and Evans (5,924,074), as applied to claim 39, and further in view of Rensimer et al. (5,845,253), for substantially the same reasons given in the previous Office Action. Further reasons appear below.

(A) Claims 54-55 have not been amended, and are therefore rejected for the same reasons given in the previous Office Action, and incorporated herein.

### ***Response to Arguments***

9. Applicant's arguments filed 27 April 2006 have been fully considered but they are not persuasive. Applicant's arguments will be addressed below in the order in which they appear in the response filed on 27 April 2006.

(A) At pages 9-12 of the response filed on 27 April 2006, Applicant argues that there is no motivation or suggestion to combine the applied references. At pages 12-14 of the response filed on 27 April 2006, Applicant argues that the cited references do not provide a reasonable expectation of success or an explanation of how they would be combined to teach or suggest the claimed invention.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, each limitation recited in claims 39, 42-51, and 53-61 has been addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Keyes, Jones, Evans, and Rensimer based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as clearly detailed in the remarks and explanations given above, and incorporated herein. Further, the Examiner respectfully submits that she has at least she has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention. Note, for example, the motivation explicitly stated in section 7(A) for combining Evans within Keyes and Jones of "quickly and efficiently capturing patient data (Evans; col. 2 lines 20-45)."

In response to applicant's argument that the cited references do not provide a reasonable expectation of success or an explanation of how they would be combined to teach or suggest the claimed invention, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the

primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In this case, the Examiner has provided an explanation of how the references would be combined to teach or suggest the claimed invention. Note the discussion in the previous Office Action with regards to claim 39.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In the present case, the Examiner has relied upon the reasoning of one of ordinary skill in the art and motivation pulled from one or more of the cited references to support the holding of obviousness.

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (571) 272-



6767. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (571) 272-6776.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**11. Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**Or faxed to:**

(571) 273-8300	[Official communications]
(571) 273-8300	[After Final communications labeled "Box AF"]
(571) 273-6767	[Informal/ Draft communications, labeled "PROPOSED" or "DRAFT"]


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Hand-delivered responses should be brought to the Knox Building, Alexandria, VA.

CB

CB

June 28, 2006

  
JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER